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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,919	04/14/2004	Masaharu Miyahisa	F-8224	6120
28107 7590 05/23/2008 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168				
EXAMINER				
RUTHKOSKY, MARK				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
05/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/823,919

**Applicant(s)**

MIYAHISA ET AL.

**Examiner**

Mark Ruthkosky

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 3 and 5-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-893)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/29/2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

The rejection of claims 3-12 under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling has been overcome by applicant's amendment to the claims.

The rejection of claims 3-12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome by applicant's amendment to the claims.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by, OR in the alternative being unpatentable under 35 U.S.C. 103(a) over Umiya et al. (JP 62-136,759).

The instant claims are to a battery comprising an electrode group formed from battery electrode plates of a positive electrode and a negative electrode spirally wound with a separator interposed there between; a battery case for housing said electrode group; and at least one of the battery electrode plates being manufactured by a method. MPEP 2113 states, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

The Umiya reference teaches a battery comprising an electrode group formed from battery electrode plates of a positive electrode and a negative electrode alternately laminated with a separator interposed there between (abstract and figures 1-5.) Figures 2-3 show at least one of the batter electrodes. The electrode includes a portion with active material and a portion without active material. The portions are compressed to have the same thickness across the length (as described in the section referring to Figure 2B.) A lead is welded/connected to the electrode. The positive and negative electrodes include these elements. The battery further comprises an electrode group formed from battery electrode plates of a positive electrode and a negative electrode spirally wound with a separator interposed there between; and a prismatic battery case for housing said electrode group (figure 4 and the corresponding text.) The reference teaches that the exposed portion is linear and compressed to a uniform thickness. Since the electrode is compressed to a desired thickness, there will be no deviation and substantially true straight boundaries. As the exposed portion has no active material, it would have less than 4% active material. Since the electrode has the same structure across the plate, it would inherently have a substantially equal strength at the exposed portion. Thus, the claims are anticipated.

With regard to claims 5, 7, and 8, the apparatus used to manufacture the product is not given patentable weight. With regard to claims 6 and 9, the pressed portions are relative to one another in the process and the relationship is not given patentable weight. With regard to claim 10, the step impregnating the entire core substrate before work pressing is not given patentable weight. As the active material is filled into the substrate in a manner equivalent to the instant application and pressed, the impregnation density will be equivalent.

As the claims include a different method than the prior art, the claims are further rejected under 35 U.S.C. 103(a) (see MPEP 2112, form paragraph 7.27(d).) The prior art does not teach the same method of making the electrode as claimed, however the claims are to a product. MPEP 2113 states, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Claims 3 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umiya et al. (JP 62-136,759).

The teachings of Umiya have been presented. The reference teaches that the electrode is compressed to a desired thickness equal in the coated and uncoated regions, but is silent to a deviation of such a substantially true straight boundary. It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a true straight boundary because the electrodes are combined with an opposing electrode through an electrolyte filled separator to form a battery. A straight boundary will increase contact between adjacent electrodes and separator portions to allow for uniform contact between the electrolyte/separator and the electrodes to give improved capacity because no unused space will form between uniform electrodes. The artesian would have found the claimed invention to be obvious in light of the teachings of the references.

***Response to Arguments***

Applicant's arguments filed 1/24/2008 have been fully considered but they are moot based on the new grounds of rejection. The previous rejection was overcome by applicant's amendments to the claims.

***Examiner Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Ruthkosky whose telephone number is 571-272-1291. The examiner can normally be reached on FLEX schedule (generally, Monday-Thursday from 9:00-6:30.) If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free.)

/Mark Ruthkosky/

Primary Examiner, Art Unit 1795